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Filing date: **11/12/2013**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92057967
Party	Defendant Space IBZ Planet, S.L.
Correspondence Address	SEAN S SWIDLER IP HORGAN LTD 1130 LAKE COOK ROAD , SUITE 240 BUFFALO GROVER, IL 60089 UNITED STATES mail@iphorgan.net
Submission	Motion to Suspend for Civil Action
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Signature	/sss/
Date	11/12/2013
Attachments	SPACE DANCE CHICAGO - 11.12.13 - Motion for Suspension (37 CFR 2.117).pdf(3291638 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Reg. No. : 4257881
Mark : SPACE DANCE CHICAGO & Device
Respondent : Space IBZ Planet, S.L.

Club Space Management, LLC)	
d/b/a Club Space)	
)	
Petitioner,)	Cancellation No. 92057967
)	
v.)	
)	
Space IBZ Planet, S.L.,)	
)	
Respondent.)	

**RESPONDENT'S MOTION TO SUSPEND CANCELLATION ACTION
PENDING FINAL DISPOSITION OF PENDING CIVIL LITIGATION**

Respondent, Space IBZ Planet, S.L. ("Respondent"), by and through its undersigned attorneys, hereby moves the Board to suspend this Cancellation Action No. 92057967 pursuant to 37 CFR Sect. 2.117(a) and TBMP Sect. 510 pending the disposition of pending civil litigation between the parties in the United States District Court for the Southern District of New York, namely, *Club Space Management, LLC, d.b.a. CLUBSPACE v. Eden Ballroom LLC and Space IBZ Planet, S.L.*, Case No. 13 CV 7955. A copy of the Complaint and Summons in the pending civil action is attached hereto as Exhibit A.

CFR Sect. 2.117(a) provides:

Whenever it shall come to the attention of the Trademark Trial and Appeal Board that a party or parties to a pending case are engaged in a civil action or another Board proceeding which may have a bearing on the case, proceedings before the Board may be suspended until termination of the civil action or the other Board proceeding.

General Motors Corp. v. Cadillac Club Fashions Inc., 22 USPQ2d 1933 (TTAB 1992). In the general, the Board exercises its discretion to suspend proceedings where the final determination of the civil action will have a bearing on the issues before the Board. *Other Telephone Co., v. Connecticut National Telephone Co.*, 181 USPQ 225 (TTAB 1974), *petition*

denied, 181 USPQ 779 (Comm'r 1974); *Whopper-Burger, Inc. v. Burger King Corp.*, 171 USPQ 805 (TTAB 1971).

Here disposition of the civil action may have a bearing on the issues before the Board. The allegations raised by the Petitioner in the Complaint and in this Cancellation Petition are identical, essentially identical, and/or closely related and the relief sought by the Petitioner in the Cancellation Petition is identical to the relief sought by the Petitioner in the Complaint, as it pertains to U.S. Trademark Reg. No. 4257881. Accordingly, disposition of the issues raised by Petitioner in the Complaint will have a bearing on the issues before the Board, and may well be dispositive. Therefore, the criteria used to determine whether an *inter partes* proceeding should be suspended pursuant to 37 CFR Sect. 2.117(a) have been met.

Moreover, concerns of judicial economy, fairness to the parties, and avoidance of piecemeal litigation, are all factors favoring suspension of this proceeding.

FOR THE ABOVE STATED REASONS, suspension of the present opposition proceeding is appropriate and in accordance with the 37 CFR Sect. 2.117(a) and is consistent with the furtherance of judicial economy. Respondent, Space IBZ Planet, S.L., respectfully requests that the Board issue an Order accordingly.

Respectfully Submitted,

Date: November 12, 2013

/Sean S. Swidler/
IpHorgan, Ltd.
1130 W. Lake Cook Rd., Suite 240
Buffalo Grove, Illinois 60089
Tel: (847) 808-5500
Fax: (847) 808-7238
Email: mail@iphorgan.net
sswidler@iphorgan.net

EXHIBIT A

NOV 08 2013

The JS-44 civil cover sheet and the information contained herein neither replace nor supplement the filing and service of pleadings or other papers as required by law, except as provided by local rules of court. This form, approved by the Judicial Conference of the United States in September 1974, is required for use of the Clerk of Court for the purpose of initiating the civil docket sheet.

PLAINTIFFS

CLUBSPACE Management, LLC, d.b.a. CLUBSPACE

DEFENDANTS

Eden Ballroom LLC
SPACE IBZ Planet, S.L.

ATTORNEYS (FIRM NAME, ADDRESS, AND TELEPHONE NUMBER)

VENABLE LLP
1270 Avenue of the Americas, 24th Floor
New York, New York 10020

ATTORNEYS (IF KNOWN)

CAUSE OF ACTION (CITE THE U.S. CIVIL STATUTE UNDER WHICH YOU ARE FILING AND WRITE A BRIEF STATEMENT OF CAUSE)
(DO NOT CITE JURISDICTIONAL STATUTES UNLESS DIVERSITY)

Willful Trademark Infringement, False Designation of Origin, and False/Fraudulent Registration of Trademark, 15 U.S.C. ss 1051 et seq.

Has this or a similar case been previously filed in SDNY at any time? No ☒ Yes ☐ Judge Previously AssignedIf yes, was this case Vol. ☐ Invol. ☐ Dismissed. No ☐ Yes ☐ If yes, give date _____ & Case No. _____IS THIS AN INTERNATIONAL ARBITRATION CASE? No ☒ Yes ☐

(PLACE AN [x] IN ONE BOX ONLY)

NATURE OF SUIT

TORTS

ACTIONS UNDER STATUTES

CONTRACT

- ☐ 110 INSURANCE
- ☐ 120 MARINE
- ☐ 130 MILLER ACT
- ☐ 140 NEGOTIABLE INSTRUMENT
- ☐ 150 RECOVERY OF OVERPAYMENT & ENFORCEMENT OF JUDGMENT
- ☐ 151 MEDICARE ACT
- ☐ 152 RECOVERY OF DEFAULTED STUDENT LOANS (EXCL VETERANS)
- ☐ 153 RECOVERY OF OVERPAYMENT OF VETERAN'S BENEFITS
- ☐ 160 STOCKHOLDERS SUITS
- ☐ 190 OTHER CONTRACT
- ☐ 195 CONTRACT PRODUCT LIABILITY
- ☐ 196 FRANCHISE

REAL PROPERTY

- ☐ 210 LAND CONDEMNATION
- ☐ 220 FORECLOSURE
- ☐ 230 RENT LEASE & EJECTMENT
- ☐ 240 TORTS TO LAND
- ☐ 245 TORT PRODUCT LIABILITY
- ☐ 290 ALL OTHER REAL PROPERTY

PERSONAL INJURY

- ☐ 310 AIRPLANE
- ☐ 315 AIRPLANE PRODUCT LIABILITY
- ☐ 320 ASSAULT, LIBEL & SLANDER
- ☐ 330 FEDERAL EMPLOYERS' LIABILITY
- ☐ 340 MARINE
- ☐ 345 MARINE PRODUCT LIABILITY
- ☐ 350 MOTOR VEHICLE
- ☐ 355 MOTOR VEHICLE PRODUCT LIABILITY
- ☐ 360 OTHER PERSONAL INJURY

ACTIONS UNDER STATUTES

CIVIL RIGHTS

- ☐ 441 VOTING
- ☐ 442 EMPLOYMENT
- ☐ 443 HOUSING/ACCOMMODATIONS
- ☐ 444 WELFARE
- ☐ 445 AMERICANS WITH DISABILITIES - EMPLOYMENT
- ☐ 446 AMERICANS WITH DISABILITIES - OTHER
- ☐ 440 OTHER CIVIL RIGHTS (Non-Prisoner)

PERSONAL INJURY

- ☐ 362 PERSONAL INJURY - MED MALPRACTICE
- ☐ 365 PERSONAL INJURY PRODUCT LIABILITY
- ☐ 368 ASBESTOS PERSONAL INJURY PRODUCT LIABILITY

PERSONAL PROPERTY

- ☐ 370 OTHER FRAUD
- ☐ 371 TRUTH IN LENDING
- ☐ 380 OTHER PERSONAL PROPERTY DAMAGE
- ☐ 385 PROPERTY DAMAGE PRODUCT LIABILITY

PRISONER PETITIONS

- ☐ 510 MOTIONS TO VACATE SENTENCE 20 USC 2255
- ☐ 530 HABEAS CORPUS
- ☐ 535 DEATH PENALTY
- ☐ 540 MANDAMUS & OTHER

PRISONER CIVIL RIGHTS

- ☐ 550 CIVIL RIGHTS
- ☐ 555 PRISON CONDITION

FORFEITURE/PENALTY

- ☐ 610 AGRICULTURE
- ☐ 620 OTHER FOOD & DRUG
- ☐ 625 DRUG RELATED SEIZURE OF PROPERTY
- ☐ 630 LIQUOR LAWS
- ☐ 640 RR & TRUCK
- ☐ 650 AIRLINE REGS
- ☐ 660 OCCUPATIONAL SAFETY/HEALTH
- ☐ 690 OTHER

LABOR

- ☐ 710 FAIR LABOR STANDARDS ACT
- ☐ 720 LABOR/MGMT RELATIONS
- ☐ 730 LABOR/MGMT REPORTING & DISCLOSURE ACT
- ☐ 740 RAILWAY LABOR ACT
- ☐ 790 OTHER LABOR LITIGATION
- ☐ 791 EMPL RET INC SECURITY ACT

IMMIGRATION

- ☐ 462 NATURALIZATION APPLICATION
- ☐ 463 HABEAS CORPUS-ALIEN DETAINEE
- ☐ 465 OTHER IMMIGRATION ACTIONS

BANKRUPTCY

- ☐ 422 APPEAL 28 USC 158
- ☐ 423 WITHDRAWAL 28 USC 157

PROPERTY RIGHTS

- ☐ 820 COPYRIGHTS
- ☐ 830 PATENT
- ☒ 840 TRADEMARK

SOCIAL SECURITY

- ☐ 861 HIA (1395ff)
- ☐ 862 BLACK LUNG (923)
- ☐ 863 DIWC/DIWW (405(g))
- ☐ 864 SSID TITLE XVI
- ☐ 865 RSI (405(g))

FEDERAL TAX SUITS

- ☐ 870 TAXES (U.S. Plaintiff or Defendant)
- ☐ 871 IRS-THIRD PARTY 26 USC 7609

OTHER STATUTES

- ☐ 400 STATE REAPPORTIONMENT
- ☐ 410 ANTITRUST
- ☐ 430 BANKS & BANKING
- ☐ 450 COMMERCE
- ☐ 460 DEPORTATION
- ☐ 470 RACKETEER INFLUENCED & CORRUPT ORGANIZATION ACT (RICO)
- ☐ 480 CONSUMER CREDIT
- ☐ 490 CABLE/SATELLITE TV
- ☐ 810 SELECTIVE SERVICE
- ☐ 850 SECURITIES/COMMODITIES/EXCHANGE
- ☐ 875 CUSTOMER CHALLENGE 12 USC 3410
- ☐ 890 OTHER STATUTORY ACTIONS
- ☐ 891 AGRICULTURAL ACTS
- ☐ 892 ECONOMIC STABILIZATION ACT
- ☐ 893 ENVIRONMENTAL MATTERS
- ☐ 894 ENERGY ALLOCATION ACT
- ☐ 895 FREEDOM OF INFORMATION ACT
- ☐ 900 APPEAL OF FEE DETERMINATION UNDER EQUAL ACCESS TO JUSTICE
- ☐ 950 CONSTITUTIONALITY OF STATE STATUTES

Check if demanded in complaint:

CHECK IF THIS IS A CLASS ACTION UNDER F.R.C.P. 23

DO YOU CLAIM THIS CASE IS RELATED TO A CIVIL CASE NOW PENDING IN S.D.N.Y.? IF SO, STATE:

DEMAND \$ _____ OTHER _____ JUDGE _____ DOCKET NUMBER _____

Check YES only if demanded in complaint

JURY DEMAND: ☒ YES ☐ NO

NOTE: Please submit at the time of filing an explanation of why cases are deemed related.

(PLACE AN x IN ONE BOX ONLY)

ORIGIN

- ☒ 1 Original Proceeding ☐ 2 Removed from State Court ☐ 3 Remanded from Appellate Court ☐ 4 Reinstated or Reopened ☐ 5 Transferred from (Specify District) ☐ 6 Multidistrict Litigation ☐ 7 Appeal to District Judge from Magistrate Judge Judgment
- ☐ a. all parties represented ☐ b. At least one party is pro se.

(PLACE AN x IN ONE BOX ONLY)

BASIS OF JURISDICTION

IF DIVERSITY, INDICATE
CITIZENSHIP BELOW.
(28 USC 1332, 1441)

- ☐ 1 U.S. PLAINTIFF ☐ 2 U.S. DEFENDANT ☒ 3 FEDERAL QUESTION (U.S. NOT A PARTY) ☐ 4 DIVERSITY

CITIZENSHIP OF PRINCIPAL PARTIES (FOR DIVERSITY CASES ONLY)

(Place an [X] in one box for Plaintiff and one box for Defendant)

CITIZEN OF THIS STATE	PTF DEF [] []	CITIZEN OR SUBJECT OF A FOREIGN COUNTRY	PTF DEF [] []	INCORPORATED and PRINCIPAL PLACE OF BUSINESS IN ANOTHER STATE	PTF DEF [] []
CITIZEN OF ANOTHER STATE	[] []	INCORPORATED or PRINCIPAL PLACE OF BUSINESS IN THIS STATE	[] []	FOREIGN NATION	[] []

PLAINTIFF(S) ADDRESS(ES) AND COUNTY(IES)

CLUBSPACE Management, LLC, d.b.a. CLUBSPACE:
34 N.E. 11th Street, Miami, Miami-Dade County, Florida 33132

DEFENDANT(S) ADDRESS(ES) AND COUNTY(IES)

Defendant Eden Ballroom LLC: (i) 500 Mamaroneck Ave., Ste. 503, Harrison, Westchester County, New York 10528; and (ii) 637 W. 50th Street, New York, New York County, New York 10019.
Defendant SPACE IBZ Planet, S.L.: Juan de Austria, Eivissa (Islas Baleares), E-07800, Spain

DEFENDANT(S) ADDRESS UNKNOWN

REPRESENTATION IS HEREBY MADE THAT, AT THIS TIME, I HAVE BEEN UNABLE, WITH REASONABLE DILIGENCE, TO ASCERTAIN THE RESIDENCE ADDRESSES OF THE FOLLOWING DEFENDANTS:

Check one: THIS ACTION SHOULD BE ASSIGNED TO: ☐ WHITE PLAINS ☒ MANHATTAN
(DO NOT check either box if this a PRISONER PETITION/PRISONER CIVIL RIGHTS COMPLAINT.)

DATE 11-08-2013 SIGNATURE OF ATTORNEY OF RECORD

ADMITTED TO PRACTICE IN THIS DISTRICT

[] NO
☒ YES (DATE ADMITTED Mo. 12 Yr. 1997)
Attorney Bar Code # MB2953

RECEIPT #

Magistrate Judge is to be designated by the Clerk of the Court.

Magistrate Judge _____ is so Designated.

Ruby J. Krajick, Clerk of Court by _____ Deputy Clerk, DATED _____

UNITED STATES DISTRICT COURT (NEW YORK SOUTHERN)

UNITED STATES DISTRICT COURT

for the

Southern District of New York

JUDGE KOELTL

CLUBSPACE Management LLC, d.b.a. CLUBSPACE

Plaintiff

v.

Eden Ballroom LLC; and SPACE IBZ Planet, S.L.

Defendant

13 CV 7955
Civil Action No.

SUMMONS IN A CIVIL ACTION

To: *(Defendant's name and address)* SPACE IBZ Planet, S.L.
Juan de Austria
Eivissa (Islas Baleares)
E-07800
Spain

A lawsuit has been filed against you.

Within 21 days after service of this summons on you (not counting the day you received it) — or 60 days if you are the United States or a United States agency, or an officer or employee of the United States described in Fed. R. Civ. P. 12 (a)(2) or (3) — you must serve on the plaintiff an answer to the attached complaint or a motion under Rule 12 of the Federal Rules of Civil Procedure. The answer or motion must be served on the plaintiff or plaintiff's attorney, whose name and address are: VENABLE LLP
1270 Avenue of the Americas, 24th Floor
New York, New York 10020

If you fail to respond, judgment by default will be entered against you for the relief demanded in the complaint. You also must file your answer or motion with the court.

RUBY J. KRAJICK

CLERK OF COURT

[Signature]
Signature of Clerk or Deputy Clerk

NOV 08 2013

Date: _____

Civil Action No. _____

PROOF OF SERVICE

(This section should not be filed with the court unless required by Fed. R. Civ. P. 4 (l))

This summons for *(name of individual and title, if any)* _____
was received by me on *(date)* _____.

☐ I personally served the summons on the individual at *(place)* _____
on *(date)* _____; or

☐ I left the summons at the individual's residence or usual place of abode with *(name)* _____
_____, a person of suitable age and discretion who resides there,
on *(date)* _____, and mailed a copy to the individual's last known address; or

☐ I served the summons on *(name of individual)* _____, who is
designated by law to accept service of process on behalf of *(name of organization)* _____
on *(date)* _____; or

☐ I returned the summons unexecuted because _____; or

☐ Other *(specify)*: _____

My fees are \$ _____ for travel and \$ _____ for services, for a total of \$ _____ 0.00.

I declare under penalty of perjury that this information is true.

Date: _____

Server's signature

Printed name and title

Server's address

Additional information regarding attempted service, etc:

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

CLUB SPACE MANAGEMENT, LLC, d.b.a. CLUB
SPACE,

Plaintiffs,

- against -

EDEN BALLROOM LLC; and SPACE IBZ PLANET,
S.L.,

Defendants.

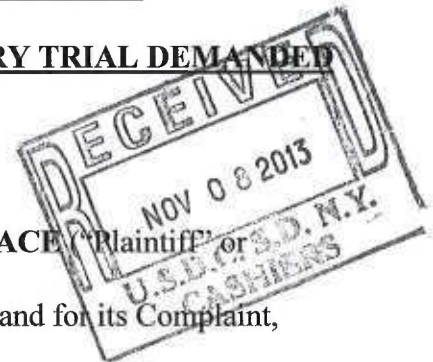
JUDGE KOELTL

13 CIV 7955

ECF CASE

COMPLAINT

JURY TRIAL DEMANDED

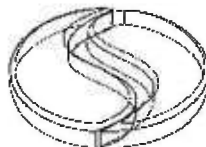


Plaintiff CLUBSPACE Management, LLC, d.b.a. CLUBSPACE ("Plaintiff" or
"CLUBSPACE"), by and through its undersigned attorneys, and as and for its Complaint,
alleges and states as follows:

NATURE OF THE ACTION

1. This is an action for (i) trademark infringement in violation of section 32(I) of the Lanham Act, 15 U.S.C. § 1114; (ii) false designation of origin and trademark infringement in violation of section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a); (iii) false or fraudulent registration of a trademark/service mark in violation of section 38 of the Lanham Act, 15 U.S.C. § 1120; and (iv) unfair competition in violation of New York State common law.

2. Defendants are about to infringe Plaintiff's registered service mark, "CLUBSPACE" and the design mark depicted below, which Plaintiff has used continuously over the past decade in connection with its internationally famous, award-winning nightclub, CLUBSPACE (voted "Best U.S. Club" at the 28th annual International Dance Music Awards, 2012).



CLUBSPACE

See U.S. Federal Trademark Registration No. 2,655,445 (registered Dec. 3, 2002) (covering nightclub services), a true and correct copy of which is attached hereto as **Exhibit A** (hereinafter, the “CLUBSPACE Mark”).

3. Since opening in 2000, CLUBSPACE has become a fixture on the dance music scene. It is unique among American nightclubs, in that it specifically targets dance music lovers of all economic backgrounds, rather than just the wealthiest, or the most beautiful, or those with the most celebrity.

4. CLUBSPACE’s 24-hour operating permit; troupe of internationally famous DJs; state-of-the-art audio and visual systems; and widespread appeal have earned it a reputation as the “go-to” dance music in the United States. Its staff, including security personnel, are trained to provide every customer with the same level of attentive service. Thus, when American partygoers hear the term “SPACE” in connection with nightclub services, they immediately think of Plaintiff’s CLUBSPACE, with its egalitarian nature and all-night parties and events.

5. In October 2013, Defendants Eden Ballroom LLC (“Eden”) and Space IBZ Planet, S.L. (“IBZ”) (Eden and IBZ together, “Defendants”) announced plans to collaborate on a new nightclub in New York, New York. Defendants decided to call that club “SPACE NY.”

6. As below, the term “SPACE NY” as a business name in connection with nightclub services is confusingly similar to and infringes upon Plaintiff’s CLUBSPACE Mark.

7. Compounding matters, Defendants’ SPACE NY would be extremely similar to Plaintiff’s CLUBSPACE, in that, without limitation, both clubs would: (i) target the same age-music demographic (dance music enthusiasts); (ii) occupy similar architectural spaces (vintage warehouses with multiple stores and large open areas for dancing); (iii) have state-of-the-art

sound, lighting, and visual systems (“intelligent lighting”); and (iv) attract top DJ and live music talent from across the globe.

8. Both dance music nightclubs would have the capacity to accommodate 1000+ guests at a time, meaning they would occupy the same genre of “mega-” or “super-clubs” in the United States.

9. Defendants’ use of the confusingly similar business name “SPACE NY” is also willful, malicious, and in deliberate disregard of the CLUBSPACE Mark. As set forth below, Defendants selected the name “SPACE NY” with full knowledge of CLUBSPACE, the CLUBSPACE Mark, and value and goodwill associated therewith. While Defendant IBZ may argue that it has U.S. Federal Trademark Registrations for “SPACE DANCE,” “SPACE DANCE NEW YORK,” and variations thereof for nightclub services, in fact, CLUBSPACE has already alleged and has, in October 2013, filed cancellation actions with the U.S. Trademark Trials and Appeals Board (“TTAB”), contending that Defendant IBZ obtained such registrations fraudulently and that they are invalid.

10. Through this lawsuit, CLUBSPACE seeks damages for Defendants’ willful trademark infringement, willful false designation of origin, and willful unfair competition. CLUBSPACE also seeks an order from this Court restraining and enjoining Defendants’ from using the confusingly similar business name “SPACE NY” in connection with nightclub services in the United States, or in any other manner that is infringing or causes Defendants to unfairly compete with CLUBSPACE.¹

11. In the alternative, at an appropriate time, CLUBSPACE reserves the right to seek statutory and/or enhanced damages for willful trademark infringement from this Court.

¹ CLUBSPACE, however, does not seek an order restraining or enjoining Defendants from opening a nightclub in the United States under a different, non-infringing business name, which they are entitled to do.

12. CLUBSPACE further seeks cancellation of Defendant IBZ's confusingly similar trademarks, below, which were registered fraudulently with the U.S. Patent and Trademark Office ("USPTO"), are confusingly similar to Plaintiff's prior CLUBSPACE Mark, and/or have never been "used" in commerce in the United States:

- a. SPACE DANCE (Reg. No. 3,233,552) (Cancellation Action No. 92057974);
- b. SPACE IBIZA (Reg. No. 4,065,934) (Cancellation Action No. 92057989);
- c. SPACE DANCE CHICAGO (Reg. No. 4,257,881) (Cancellation Action No. 92057967);
- d. SPACE DANCE NEW YORK (Reg. No. 4,214,158) (Cancellation Action No. 92057987);
- e. SPACE DANCE MIAMI (Reg. No. 4,257,882) (Cancellation Action No. 92057968); and
- f. SPACE DANCE LAS VEGAS (Reg. No. 4,257,875) (Cancellation Action No. 92057976).

Plaintiff's Petitions seeking cancellation of the above-referenced marks are incorporated by reference herein.

JURISDICTION AND VENUE

13. This Court has subject matter jurisdiction over CLUBSPACE's Lanham Act claims pursuant to 15 U.S.C. § 1121 (trademark) and 28 U.S.C. §§ 1331 (federal question) and 1338(a) (trademark).

14. This Court has subject matter jurisdiction over CLUBSPACE's New York common law claim pursuant to 28 U.S.C. § 1338(b) (claim of unfair competition joined with substantial and related trademark claims) and 28 U.S.C. § 1367(a) (claims that are so related to

the claims in the Action within the Court's original jurisdiction that they form part of the same case or controversy).

15. This Court has jurisdiction to order cancellation of Defendant IBZ's registered U.S. trademarks, described more fully below, pursuant to 15 U.S.C. § 1119 (power of federal court over registration).

16. Venue is proper in this judicial district pursuant to 28 U.S.C. § 1391 in that, among other things, a substantial portion of the events or omissions giving rise to the Action occurred in this judicial district.

THE PARTIES

Plaintiff

17. Plaintiff CLUBSPACE is a limited liability company duly organized and existing under the laws of the state of Florida, with an address at 34 N.E. 11th Street, Miami, Florida 33132. As detailed below, CLUBSPACE is in the business of operating nightclubs and providing bar and entertainment services, including at the dance music nightclub CLUBSPACE, located at 34 N.E. 11th Street, Miami, Florida 33132.

Defendants

18. Defendant IBZ is a corporation organized and existing under the laws of Spain, with an address of Juan de Austria, Eivissa (Islas Baleares), E-07800, Spain. Like Plaintiff, Defendant IBZ is in the business of operating nightclubs and providing bar and entertainment services. However, unlike Plaintiff, Defendant IBZ has not operated any nightclubs in the United States until now. Defendant IBZ's U.S. operations have thus far been limited to infrequent, single-night events hosted by established nightclubs in different U.S.-cities.

19. Defendant Eden is a limited liability corporation organized and existing under the laws of New York with a registered address with the New York Department of State of 500 Mamaroneck Ave., Ste. 503, Harrison, New York 10528. Upon information and belief, Defendant Eden operates several nightclubs and lounges, including Taj Lounge, in New York, New York.

20. Upon information and belief, Defendants have entered into an agreement between IBZ and Eden to open the new nightclub, SPACE NY, at 637 W 50th Street (between 11th and 12th Avenues) in New York, New York.

21. Upon information and belief, Defendant Eden is Defendant IBZ's licensee in the United States, and Defendant Eden has applied for and has received permits to operate under the business name "SPACE NY" in New York, New York, as described more fully below.

STATEMENT OF FACTS

Plaintiff's CLUBSPACE and the CLUBSPACE Mark

22. For over a decade, Plaintiff has owned and operated the internationally-popular, award-winning nightclub CLUBSPACE.

23. Today, CLUBSPACE is a fixture of American dance music. However, when CLUBSPACE first opened its doors in 2000, critics were skeptical that a dance music nightclub in downtown Miami, Florida, could succeed.

24. To distinguish itself, CLUBSPACE adopted a concentrated marketing push that emphasized an egalitarian, no-nonsense approach toward customers and dance music.

25. CLUBSPACE has employed this no-nonsense approach throughout the 13+ years of its operations.

26. Whereas some “destination” nightclubs and lounges catered to the international “jet-set,” also known as the “models-and-bottles” or “VIP” crowds, CLUBSPACE has always targeted dance music lovers of all economic backgrounds.

27. CLUBSPACE’s events and related advertising, marketing, and promotional materials are talent-driven, in that they feature the DJs, musicians, or other “talent” performing at the nightclub, as opposed to the wealth, attractiveness, or celebrity of their clientele.

28. CLUBSPACE’s physical layout featuring over 30,000 square feet of dance floor promotes energetic dancing, rather than passive “lounging” in segregated “VIP” areas.

29. Day-to-day, the majority of CLUBSPACE customers enter through the General Admission (“GA”) entrance. This entrance is continually staffed by security personnel who check identification, collect “cover” charges, and admit patrons standing in line.

30. Unlike at other nightclubs, CLUBSPACE security personnel do not have a “VIP” list or permit guests to “jump the line” (an infamous industry practice of granting wealthy, attractive, or high-profile clientele preferred access to the nightclub). Instead, CLUBSPACE security personnel have a “guest list,” which offers complimentary admission to patrons with reservations, but still requires them to wait in line.

31. After midnight, when the majority of guests arrive at CLUBSPACE, all customers must pay “cover,” and everyone must wait in line. Thus, the vast majority of CLUBSPACE customers both pay “cover” and wait in line.

32. Other features of CLUBSPACE make it ideal for dance music enthusiasts, as opposed to just “VIPs.”

33. First, the “cover” charges collected at CLUBSPACE are generally less expensive than “cover” charges imposed at competing nightclubs. CLUBSPACE has made it a practice not to “gouge” customers with excessive fees.

34. Similarly, the alcoholic beverages and other services offered at CLUBSPACE are less expensive than equivalent alcoholic beverages and services offered by other clubs.

35. CLUBSPACE employees are also specifically trained to provide attentive customer service to all patrons, and the security personnel are instructed to act with integrity and professionalism at all times.

36. This is intentional, so as to provide dance music lovers of all backgrounds with a similar nightclub experience.

37. CLUBSPACE also has a 24-hour operating permit, which allows customers to dance—literally—all day and night.

38. Closing times after 12:00 P.M. the following day are actually common at CLUBSPACE.

39. Such extended operating times mean patrons can choose to come earlier or later, and the nightclub can accommodate an extremely large number of customers every day.

40. In fact, one of CLUBSPACE’s most popular operating times is during their “Sunrise” session, held on the sky-lit “Terrace” from 4:00 A.M. until after 8:00 A.M, during which dancers can enjoy top DJ talent while watching the sun rise.

41. CLUBSPACE also boasts state-of-the-art audio and visual systems, featuring “intelligent lighting” that is timed/themed to the music.

42. The large crowds of dancers who are attracted to this high-tech, high-energy nightclub atmosphere are incompatible with the exclusivity prized by other clubs.

43. Customers—who come to CLUBSPACE from all over the country—recognize CLUBSPACE as one of the premier dance music venues in the United States. A survey of ZIP codes collected from CLUBSPACE’s customers will confirm that many of its guests are from the Northeast, including from New York, New York, where CLUBSPACE considered a “destination” club.

44. Plaintiff’s CLUBSPACE Mark—which appears on all advertising, marketing, and promotional material distributed by CLUBSPACE—is also famous in its own right.

45. The CLUBSPACE Mark was registered on December 3, 2002, and was granted “incontestable” status by the USPTO on March 28, 2009. *See* 15 U.S.C. §§ 1058, 1065.

46. Since registration, the CLUBSPACE Mark has been featured on/in connection with CLUBSPACE’s:

- a. Website (www.clubspace.com), blog, and other social media, which also feature futuristic design elements, *e.g.*:



Source: www.clubspace.com



Source: www.clubspace.com/blogs/



Source: www.facebook.com/ClubSpace/

- b. Podcasts (e.g., “CLUBSPACE Podcast”; “SPACE Nation Podcast”; and “SPACE Miami Podcast”):



Source: www.apple.com/us/podcast/space-miami-podcast/id468802120/

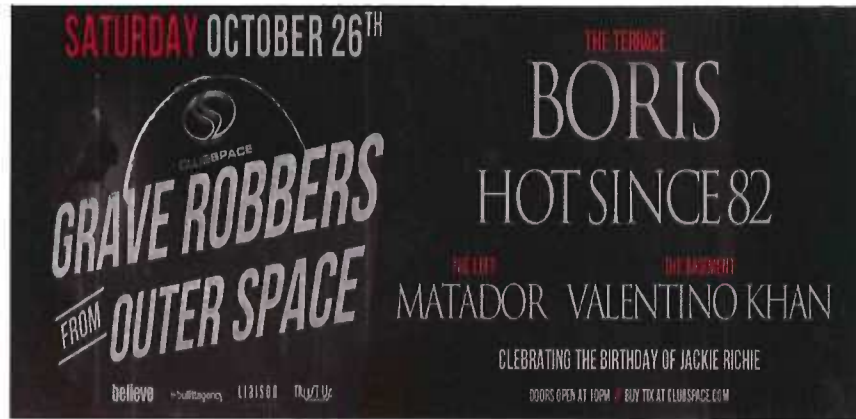


Source: www.clubspace.com/; and

- c. Themed events and parties, (see www.clubspace.com/events/) :

FRIDAY, AUGUST 30TH 2013 / LABOR DAY WEEKEND
 FEATURING
SHOWTEK [MS54] ETC! ETC!
 MYON & SHANE 54 prototype
KARAO **LUCID** **Joseph** **DYNAMIK** **REX**
CHRIS **JASON** **Felix & MAX** **DON KREZ** **ManStars**
KUSH **DANIEL** **HOUSE MATE** **on Broadway**
& PHVRVON **PEJEEZ** **ROYALTY**
 34 NE 11ST DOWNTOWN MIAMI // 19+ WITH PROPER ID // DOORS OPEN AT 10PM
 PURCHASE TICKETS AT: WWW.CLUBSPACE.COM
 FOR INFORMATION / HARD TIX / VIP TABLES / BIRTHDAYS / 305.879.9904
 DRESS CODE STRICTLY ENFORCED AFTER 2AM ONLY 21+ ALLOWED IN THE DOOR
 CLUB SPACE Committee

BASE SATURDAY AUGUST 10TH
 THE BASEMENT
SLANDER
JARIL
JOHNNYTERROR RADAMAS
 STARTS AT 9PM // BUY TIX AT WWW.CLUBSPACE.COM
 CLUB SPACE
 34 NE 11 STREET DOWNTOWN MIAMI
 INFO 305.375.0001 / VIP 786.357.6456
 FOR MORE INFO VISIT WWW.CLUBSPACE.COM



Source: www.clubspace.com/; www.clubspace.com/events/

See also numerous promotional flyers distributed to the public as early as 2000, copies of which are annexed hereto as **Exhibit B**.

47. CLUBSPACE also consistently receives prominent media attention in local and online news sources. See, e.g., Hammersly, Michael, "Club Space turns 10" MIAMI.COM, Nightlife, May 20, 2010, available at <http://www.miami.com/club-space-turns-10-article/>, last visited Nov. 6, 2013, a true and correct copy of which is annexed hereto as **Exhibit C**; Pajot, S., "Space Miami's Louis Puig on His Club's 12th Anniversary: 'We Have Dominated, Where Others Predicted Our Demise,'" MIAMI NEW TIMES, Blogs, May 12, 2012, available at http://blogs.miaminewtimes.com/crossfade/2012/05/space_12th_anniversary_louis_puig_comments.php/, last visited Nov. 6, 2013, a true and correct copy of which is annexed hereto as **Exhibit D**.

48. Although not specifically geared towards "VIPs" or the international "jet-set," CLUBSPACE routinely attracts "A-list" Hollywood, music, and sports celebrities. See, e.g., photographs of celebrities taken at CLUBSPACE at 34 N.E. 11th Street, Miami, Florida, true and correct copies of which are annexed hereto as **Exhibit E**; "Rihanna Is A Pot-riotic Partier in Miami!" PEREZHILTON.COM, Aug. 12, 2013, available at <http://perezhilton.com/cocoperez/2013-08-12-rihanna-american-10-deep-flag-weed-t-shirt-miami>, last visited Nov. 6, 2013, a true and correct copy of which is annexed hereto as **Exhibit F**.

49. In 2012, CLUBSPACE was listed among DJ MAG's "Top 100 Clubs List," (available at <http://www.djmag.com/content/club-space>, last visited Nov. 6, 2013, a true and correct copy of which is annexed hereto as **Exhibit G**) (#46)) and was voted "Best US Club" at the 28th Annual International Dance Music Awards, (see "28th Annual International Dance Music Awards announce results, name Armin van Buuren as Best Producer,"

DANCINGASTRONAUT.COM, available at <http://www.dancingastronaut.com/2013/03/28th-annual-international-dance-music-awards-announce-results-name-armin-van-buuren-as-best-producer/>, last visited Nov. 6, 2013, a true and correct copy of which is annexed hereto as **Exhibit H**).

50. Notably, many of these publications and award refer to CLUBSPACE by the abbreviated term “SPACE.”

51. Similarly, CLUBSPACE employees, including security personnel, refer to the nightclub as just “SPACE.”

52. Actual customers visiting CLUBSPACE also refer to it simply as “SPACE.”

53. CLUBSPACE has also been featured on television as “SPACE.” In 2010, when network television channel MTV was filming the popular Jersey Shore reality television show in Miami, Florida, one of the castmates, Jenni (“JWOWW”), devised a plan to cheer up homesick castmate, Nicole (“Snooki”), by taking her to CLUBSPACE. See “Jersey Shore (Season 2) | Ep. 12 | Sneak Peak,” MTV.COM, available at <http://www.mtv.com/videos/misc/581108/going-to-space.jhtml>, last visited Nov. 6, 2013.

54. Jenni tells the camera that “the place [she] has been dying to go to this whole time in Miami is SPACE . . . the party doesn’t stop ‘till like 2:00 in the afternoon the next day.” *Id.*

55. Nicole responds by excitedly screaming “SPACE!,” then running through the house yelling, “We’re going to SPACE!” *Id.*

56. This episode has been broadcast repeatedly on MTV television, as well as featured on MTV’s website, giving CLUBSPACE extensive publicity as “SPACE” aimed at its targeted demographic market.

57. Plaintiff's advertising campaigns also feature the abbreviated term "SPACE," as opposed to Plaintiff's full name, CLUBSPACE (*e.g.*, "Take me to **SPACE**" and "**SPACE** Nation" campaigns).

58. Thus, when American consumers hear the term "SPACE" in connection with nightclubs and related services, they naturally associate that term with the Plaintiff and Plaintiff's nightclub, CLUBSPACE, as opposed to some other entity.

59. Even out-of-town guests hailing from New York, New York, understand the term "SPACE" to refer to Plaintiff's CLUBSPACE in Miami, Florida.

Defendants' Adoption of the Confusingly Similar Term "SPACE NY" as a Business Name

60. Upon information and belief, Defendant IBZ operates a chain of non-U.S. nightclubs known as Space Ibiza (Ibiza, Spain); Space B. Camboriu (Santa Catarina, Brazil); Space Dubai (Dubai, United Arab Emirates); and Space Sharm (Sharm el-Shiekh, Egypt), among others.

61. As of the date of this Complaint, Defendant IBZ operates no U.S. nightclubs and has only hosted a handful of infrequent, single-night parties in the United States.

62. Defendant Eden is an established owner/operator of U.S. nightclubs, including Taj Lounge in New York, New York.

63. Plaintiffs have investigated, and Defendant Eden has never operated a U.S. nightclub using the term "SPACE" or any variation thereof.

64. In October 2013, Defendants publicly announced plans to collaborate and open a new nightclub, d.b.a. SPACE NY, in New York, New York.

65. Upon information and belief, the grand-opening will occur on Wednesday, November 27, 2013, also known as "Thanksgiving Eve." *See, e.g.*, "Ibiza's Space Nightclub

expected to open New York City location on Thanksgiving Eve,” DANCINGASTRONAUT.COM, available at <http://www.dancingastronaut.com/2013/10/ibizas-space-nightclub-set-to-open-new-york-city-location-on-thanksgiving-eve/>, last visited Nov. 6, 2013, a true and correct copy of which is attached hereto as **Exhibit I**.

66. Upon information and belief, Defendant Eden is applying/has applied to use Defendant IBZ’s U.S. trademarks, including “SPACE DANCE” and “SPACE DANCE NEW YORK” in connection with nightclub services, namely, in connection with SPACE NY.

67. Defendants’ SPACE NY would occupy a large, vintage warehouse space at 637 W. 50th Street, between 11th and 12th Avenues, in New York, New York. *See* Liquor License Stipulations Application submitted by Defendant Eden to Manhattan Community Board 4, a true and correct copy of which is attached hereto as **Exhibit J**.

68. Defendants’ SPACE NY will be a dance music nightclub that will operate as a dance club and café and serve alcohol on the premises. *See id.*

69. Defendants’ SPACE NY would accommodate up to 1,240 patrons at a time and have areas for dancing spanning multiple floors. *See id.*

70. Defendants’ SPACE NY would possess a 24-hour operating permit allowing them to accommodate dancers all day and all night. *See id.*

71. Defendants’ SPACE NY would offer live music and DJ services targeting the same age-music demographic as CLUBSPACE. *See id.*

72. Upon information and belief, Defendants’ SPACE NY would have laser light shows and other visual effects timed/themed to the music.

73. Some of the customers who visit Defendants' SPACE NY will also have visited or heard of CLUBSPACE and are thus likely be confused as to the source and origin of Defendants' nightclub and related services.

74. Some patrons of Defendants' planned SPACE NY will incorrectly believe that they are visiting a dance music nightclub owned or operated by CLUBSPACE, due to the many confusing similarities between the nightclubs, including but not limited to:

- a. Architectural spaces (large, multi-story, vintage warehouses with large open areas for dancing),
- b. Atmosphere (energetic, low-lit, party atmosphere with top international dance music entertainment, laser light shows, and other visual effects, where guests are encouraged to party all night);
- c. Types of services offered (nightclub services offered, upon information and belief, 24 hours a day, seven days a week); and, most importantly for purposes of this lawsuit,
- d. Business name ("CLUBSPACE" v. "SPACE NY," both of which incorporate the operative word "SPACE" in connection with the exact same class of goods and services in the United States, and targeting the same age-music demographic).

75. There is also evidence of actual confusion, in that CLUBSPACE representatives have been contacted by peers and business partners inquiring about their "new" location in New York, New York.

76. Upon information and belief, these individuals heard that a "SPACE" nightclub was opening in New York, New York, and incorrectly assumed that the nightclub was an extension of CLUBSPACE in New York, New York, rather than an independent nightclub

operated by some other entity. Some of these individuals wanted to replicate the existing business relationships their companies had with CLUBSPACE in Miami with the “new” CLUBSPACE in New York.

77. This assumption—incorrect as it was—was reasonable, since in the nightclub industry, it is common to start a club in a single city and, if the club is popular, open satellite clubs in other cities.

78. Also in the industry, the practice of appending a city name to a nightclub suggests that the club is a “spin off” of a “mother club” in another city. Thus, “SPACE NY” would be understood to mean CLUBSPACE in New York, New York.

79. Moreover, internet websites specializing in nightlife and the entertainment industry have referred to Defendants’ nightclub as “CLUB SPACE NEW YORK” or just “CLUB SPACE,” going as far as to say, “Club Space has taken over the project to make it their own.” “NEWS: Space Ibiza To Open in New York City,” ELECTRONICAOASIS, Oct. 25, 2012, available at <http://www.electronicaoasis.com/space-ibiza-to-open-in-new-york-city/>, last visited Nov. 6, 2013; “SPACE NYC aka Club Space NYC,” SHOWTIMENY.COM, available at <http://www.showtimeny.com/Space-NYC.html>, last visited Nov. 6, 2013; true and correct copies of which are attached hereto as **Exhibit K**.

80. Defendants’ use of the SPACE NY name is therefore infringing, in that it is confusingly similar to a valid, famous, incontestable, registered trademark and business name used by Plaintiff for over 13 years, upon information and belief, before Defendants’ SPACE NY was even a pipedream.

Irreparable Harm to CLUBSPACE

81. Plaintiffs are also highly likely to suffer immediate, irreparable harm if Defendants' infringing activities are not stopped.

82. As set forth in detail above, the nature of CLUBSPACE's nightclub services as "egalitarian," in contrast to "exclusive," is the cornerstone of the CLUBSPACE brand that has allowed it to become successful.

83. But for these features, CLUBSPACE would be an ordinary dance music nightclub, subject to the same pressures of trendiness and exclusivity that plague CLUBSPACE's competitors, including, upon information and belief, Defendants.

84. Customers who enjoy dance music and who are attracted to these features may be turned off to the CLUBSPACE brand if they visit Defendants' SPACE NY, believing it to be a "spin-off" of Plaintiff's Miami mega-club, when it is not.

85. As soon as a customer's expectations about a particular nightclub are disappointed, there is a great risk they will not return; or, even worse, that they will publicize their disappointment by posting negative comments or messages on online forums and social media websites, such as on Yelp.com, or on Facebook and Twitter.

86. This is particularly damaging in the nightclub industry, where there are many different nightclubs competing for customers' business.

87. Such reputational damage can be accomplished instantaneously, but can take months or years to repair, if it can be repaired at all.

88. Customer confusion over the origin of nightclub services, and the associated negative publicity, also creates harm "up the chain," in the form of damage to vendor or business partner relationships.

89. Most importantly to CLUBSPACE, it creates a risk of harm to relationships with music talent and talent agents (DJs, live musicians, other performers, etc.), which are central to CLUBSPACE's business.

90. If CLUBSPACE's reputation suffers as a result of being unable to control the quality and nature of goods and services offered in connection with CLUBSPACE and the CLUBSPACE Mark, then it may no longer be able to attract the top international DJ and live music talent it currently attracts. By extension, loyal customers may no longer perceive CLUBSPACE as the "go-to" dance music venue in the United States.

Defendants' Infringement is Willful

91. Defendants infringing use of the term "SPACE" in connection with nightclub services is also willful, malicious, and in deliberate disregard of CLUBSPACE's rights. At the very least, Defendants selected the business name "SPACE NY" with willful blindness to CLUBSPACE's prior rights.

92. Both Defendants are well-established in the nightclub industry, and, upon information and belief, are familiar with dance music nightclubs in the United States.

93. As set forth above, CLUBSPACE is an internationally famous, award-winning nightclub that is popular in the United States. Plaintiff's CLUBSPACE Mark has been used in connection with the operation of CLUBSPACE for over a decade and appears on numerous marketing, advertising, and promotional materials disseminated by CLUBSPACE.

94. Due to Defendants' long-time, extensive involvement in the nightclub business—the same industry where CLUBSPACE operates—it is simply implausible that Defendants had no knowledge of CLUBSPACE or the CLUBSPACE Mark when they selected the name "SPACE NY."

95. Historically, Defendant IBZ has collaborated with established U.S. nightclubs to host single-night events and parties in U.S. cities.

96. Upon information and belief, at least one of those single-night parties took place in Miami, Florida, in May 2009, after Plaintiff's Miami-based CLUBSPACE was already a fixture on the American nightclub scene and popular in Miami.

97. Separately, Defendant IBZ's non-U.S.-based nightclubs appear alongside CLUBSPACE on award lists of the "best" dance music nightclubs in the world. *See, e.g.*, Exhibit H hereto (news article concerning 2012 International Dance Music Awards Recipients, including Space Ibiza (for "Best International Club") and CLUBSPACE (for "Best U.S. Club")).

98. Likewise, Defendant Eden operates numerous nightclubs in New York, New York, and, upon information and belief, Eden's owner, Anthony Piacquadio, has over 20 years of experience as an accomplished DJ, music producer, nightclub operator, and promoter.

99. This head-to-head competition and knowledge of the nightclub industry means that Defendants must have known of CLUBSPACE and the CLUBSPACE Mark when they adopted the name "SPACE NY" for their new nightclub, but selected the name anyway, in spite of Plaintiff's rights.

100. Moreover, Defendants have been specifically advised by Plaintiff's predecessor-in-interest that their use of the term "SPACE" in connection with nightclub and related services in the United States is likely to create confusion and to infringe upon the CLUBSPACE Mark.

101. Without limitation, representatives of Plaintiff's predecessor-in-interest and representatives of Defendant IBZ corresponded in December 2012 concerning Defendant IBZ's right to use the term "SPACE" in connection with nightclub and related services in the United States.

102. Again, without limitation, Plaintiff's predecessor-in-interest advised Defendant IBZ of the existence of the CLUBSPACE Mark; CLUBSPACE's established reputation in the nightclub industry in the United States; and the fact that Defendant IBZ's use of the term "SPACE" created a conflict with CLUBSPACE's pre-existing trademark rights and was infringing.

103. Furthermore, as set forth in detail below, Defendant IBZ's U.S. Federal Trademark Registrations for "SPACE DANCE," "SPACE DANCE NEW YORK" and variations thereof covering nightclub services are presently subject to cancellation actions filed by Plaintiff CLUBSPACE on October 2, 2013—*before* Defendants went public with their November 27, 2013 opening date.

104. Plaintiff has investigated extensively Defendants' supposed "use" in the United States of the marks, *below*, and has found absolutely none.

Defendant IBZ's SPACE DANCE and Related U.S. Trademarks

105. Although Defendant IBZ owns U.S. Federal Trademark Registrations for the following "SPACE DANCE" and related marks in connection with nightclub services, the specimens of "use" submitted with these registrations is the basis of Plaintiff's cancellation proceedings (currently pending), and in fact demonstrates no continuous "use" at all in the United States, as required by U.S. trademark law, (*see, e.g., Exhibit L*, hereto, a specimen demonstrating a one night only party in Las Vegas, Nevada, held several years ago):

- a. SPACE DANCE (Reg. No. 3,233,552) (registered Apr. 27, 2007);
- b. SPACE IBIZA (Reg. No. 4,065,934) (registered Dec. 8, 2011);
- c. SPACE DANCE CHICAGO (Reg. No. 4,257,881) (registered Dec. 11, 2012);
- d. SPACE DANCE NEW YORK (Reg. No. 4,214,158) (registered Sept. 25, 2012);

e. SPACE DANCE MIAMI (Reg. No. 4,257,882) (registered Dec. 11, 2012); and

f. SPACE DANCE LAS VEGAS (Reg. No. 4,257,875) (registered Dec. 11, 2012).

106. Plaintiff, however, has prior, exclusive rights to the valid, incontestable CLUBSPACE Mark, to which Defendant IBZ's marks, *above*, are confusingly similar. *See* 15 U.S.C. §§ 1064, 1065.

107. Without limitation, Plaintiff's CLUBSPACE Mark and Defendant IBZ's marks all incorporate the operative word, "SPACE," in connection with the exact same categories of goods and services, *i.e.*, nightclub services, in the United States.

108. As set forth above and at Exhibit A, the U.S. Federal Trademark Registration for Plaintiff's CLUBSPACE Mark was issued on December 3, 2002.

109. By contrast, the oldest of Defendant IBZ's SPACE DANCE registrations, Reg. No. 3,233,552 for "SPACE DANCE," was obtained in 2007.

110. Defendant IBZ's reliance on the above SPACE DANCE registrations is misplaced, since, upon information and belief, such registrations were obtained fraudulently and/or are vulnerable to cancellation based on CLUBSPACE's prior use and registration of the CLUBSPACE Mark, to which Defendant IBZ's marks are confusingly similar, and based on Defendant IBZ's non-"use."

111. On October 2, 2013, CLUBSPACE commenced six separate trademark cancellation actions with the TTAB, alleging, among other things:

- a. That Defendant Space IBZ knowingly submitted false Declarations, Statements of Use, Section 71 Statements, and/or Specimens to the USPTO, seeking to obtain/extend U.S. federal trademark protections for the SPACE DANCE, SPACE DANCE CHICAGO, SPACE DANCE NEW YORK, SPACE DANCE

MIAMI, and SPACE DANCE LAS VEGAS marks, when such registration/extension should not have been granted, because those marks had never been “used” in commerce in the United States as a matter of law;

- b. That Defendant Space IBZ’s marks, SPACE IBIZA, SPACE DANCE CHICAGO, SPACE DANCE NEW YORK, SPACE DANCE MIAMI, and SPACE DANCE LAS VEGAS, are confusingly similar to and were registered after the valid, incontestable CLUBSPACE Mark, and should never have been registered; and
- c. That Defendant Space IBZ never used the SPACE IBIZA, SPACE DANCE CHICAGO, SPACE DANCE NEW YORK, SPACE DANCE MIAMI, and SPACE DANCE LAS VEGAS marks in commerce in the United States as a matter of law and should not have been registered.

See Cancellation Petitions, Cancellation Action Nos. 92057974 (SPACE DANCE), 92057989 (SPACE IBIZA), 92057967 (SPACE DANCE CHICAGO), 92057987 (SPACE DANCE NEW YORK), 92057968 (SPACE DANCE MIAMI), and 92057976 (SPACE DANCE LAS VEGAS), available at <http://ttabvue.uspto.gov/> (TTAB/USPTO website), copies of which are incorporated by reference as though fully set forth herein.

112. Upon information and belief, Defendant IBZ also owns international and foreign trademark registrations for SPACE DANCE and related marks.

113. However, any reliance on Defendant IBZ’s international and foreign trademark registrations, and any use or fame associated therewith, is inapposite.

114. Trademark rights are territorial, in that they are granted by the sovereign powers of individual nations.

115. Defendant IBZ would not have the right to use the term “SPACE” in connection with nightclub services in the United States merely because Defendant IBZ has international or foreign trademark registrations incorporating that term in connection with nightclub services in other countries, *e.g.*, Spain, Brazil, the United Arab Emirates, and Egypt.

COUNT I

Infringement of Registered Trademarks

Section 23(I) of the Lanham Act, 15 U.S.C. § 1114

116. Plaintiff CLUBSPACE repeats and re-alleges the allegations set forth in paragraphs 1 through 115, *above*, as though fully set forth herein.

117. By their misconduct described above, Defendants have infringed CLUBSPACE’s rights in and to the CLUBSPACE Mark, which has been continuously used in commerce in the United States in connection with nightclub services for over a decade.

118. At all relevant times, Defendants were aware of CLUBSPACE prior rights in and to the CLUBSPACE Mark and of the confusingly similar nature of the business name, “SPACE NY,” which they selected to operate their new nightclub, SPACE NY, in New York, New York.

119. At the very least, Defendants acted with willful blindness or reckless indifference to CLUBSPACE’s prior, exclusive trademark rights.

120. Defendants use of the term “SPACE NY” as a business name in connection with nightclub services is likely to create consumer confusion and deception in the marketplace.

121. As a result of Defendants’ misconduct, CLUBSPACE has been, is, and will continue to be irreparably harmed—that is, unless Defendants are enjoined and restrained by this Court.

122. CLUBSPACE has no adequate remedy at law because, without limitation, (a) the CLUBSPACE Mark is unique and valuable property, which has no readily-determinable market value; (b) Defendants' infringement constitutes harm to Plaintiff CLUBSPACE such that CLUBSPACE could not be made whole by any monetary award; (c) if the Defendants' willful infringement is allowed to continue, the public is likely to become further confused, mistaken, or deceived as to the source or origin of Defendants' competing nightclub services; and (d) Defendants' willful conduct and the resulting damage to CLUBSPACE is continuing.

123. In light of the foregoing, CLUBSPACE is entitled to an injunction prohibiting Defendants from using the term "SPACE NY," or any confusingly similar term, in connection with nightclub services in the United States, and to recover from Defendants all damages CLUBSPACE has sustained, is sustaining, or will sustain, and all gains, profits, advantages, etc., obtained by Defendants as a result of their infringing acts, in an amount not yet known but to be determined at trial, and the costs of this action pursuant to 15 U.S.C. § 1117(a), or, at CLUBSPACE's option, statutory damages pursuant to 15 U.S.C. §1117(c).

124. Notably, CLUBSPACE does not seek an injunction prohibiting Defendants from collaborating to open a nightclub or to move forward with their plans to open a new nightclub in New York, New York, which they may do using a different business name.

COUNT II

False Designation of Origin/Trademark Infringement

Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a)

125. Plaintiff CLUBSPACE repeats and re-alleges the allegations set forth in paragraphs 1 through 124, *above*, as though fully set forth herein.

126. Plaintiff advertises, markets, and promotes its famous, award-winning CLUBSPACE using the CLUBSPACE Mark described above. As such, the CLUBSPACE Mark is the means by which CLUBSPACE's services are distinguished from competing services in the same field.

127. Defendants' willful misconduct described above includes the unauthorized use of the confusingly similar term "SPACE NY" as a business name in connection with nightclub services (the very same services for which Plaintiff's CLUBSPACE Mark is registered). As a result, consumers and the general public are likely to be confused as to the source and origin of Defendants' nightclub services, mistaking them for CLUBSPACE's.

128. Upon information and belief, Defendants adopted the term "SPACE NY" as a business name in connection with nightclub services, with full knowledge that doing so could mislead the public and create consumer confusion in the marketplace.

129. At the very least, Defendants have acted with willful blindness or reckless indifference to CLUBSPACE's prior, exclusive trademark rights.

130. Defendants' willful conduct described above constitutes (a) false designation of origin, (b) false or misleading description, and/or (c) false or misleading representation that the nightclub services to be offered by Defendants are in some way associated with the nightclub services already offered by Plaintiff in connection with CLUBSPACE, in violation of section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a).

131. CLUBSPACE has been, is, and will continue to be irreparably harmed as a result of Defendants' willful misconduct—that is, unless Defendants are enjoined from such conduct by the Court.

132. For the reasons set forth above, CLUBSPACE has no adequate remedy at law.

133. In light of the foregoing, CLUBSPACE is entitled to an injunction prohibiting Defendants from using the term “SPACE NY,” or any confusingly similar term, in connection with any nightclub services, and to recover from Defendants all damages CLUBSPACE has sustained, is sustaining, or will sustain, and all gains, profits, advantages, etc., obtained by Defendants as a result of their infringing acts, in an amount not yet known but to be determined at trial, and the costs of this action pursuant to 15 U.S.C. § 1117(a), or, at CLUBSPACE’s option, statutory damages pursuant to 15 U.S.C. §1117(c).

134. Again, CLUBSPACE does not seek an injunction prohibiting Defendants from collaborating to open a nightclub or to move forward with their plans to open a new nightclub in New York, New York, which they are of course at liberty to do under a different, non-infringing business name.

COUNT III

Fraudulent Registration of a Trademark

Section 38 of the Lanham Act, 15 U.S.C. § 1120

135. Plaintiff CLUBSPACE repeats and re-alleges the allegations set forth in paragraphs 1 through 134, above, as though fully set forth herein.

136. As set forth above and in detail in CLUBSPACE’s cancellation petitions filed with the TTAB on October 2, 2013, incorporated herein by reference, Defendant IBZ’s U.S. Federal Trademark Registrations for SPACE DANCE, SPACE DANCE CHICAGO, SPACE DANCE NEW YORK, SPACE DANCE MIAMI, and SPACE DANCE LAS VEGAS were obtained fraudulently, namely, through the knowing submission of materially false statements to the USPTO.

137. Without limitation, these knowing, false statements to the USPTO were that the SPACE DANCE, SPACE DANCE CHICAGO, SPACE DANCE NEW YORK, SPACE DANCE MIAMI, and SPACE DANCE LAS VEGAS marks had been used continuously in commerce in the United States, when they were not.

138. Upon information and belief, these representations were made to the USPTO for the express purpose of inducing the USPTO to issue a trademark registration/extend U.S. federal trademark protections over international/foreign trademark registrations, when such protections should not have been granted/extended.

139. Upon information and belief, these representations were material to the USPTO's decision to issue a registration/extend U.S. federal trademark protections over international/foreign trademark registrations, when such protections should not have been granted/extended.

140. As set forth above and in detail in CLUBSPACE's cancellation petitions filed with the TTAB on October 2, 2013, incorporated herein by reference, Defendant IBZ's U.S. Federal Trademark Registrations for SPACE IBIZA, SPACE DANCE CHICAGO, SPACE DANCE NEW YORK, SPACE DANCE MIAMI, and SPACE DANCE LAS VEGAS are vulnerable to cancellation on the grounds that they are confusingly similar to CLUBSPACE's prior U.S. Federal Trademark Registration for the CLUBSPACE Mark.

141. Without limitation, the SPACE IBIZA, SPACE DANCE CHICAGO, SPACE DANCE NEW YORK, SPACE DANCE MIAMI, and SPACE DANCE LAS VEGAS marks contain the same operative word, "SPACE," as Plaintiff's CLUBSPACE Mark and are registered in connection with the same class of services for which Plaintiff's CLUBSPACE

Mark is registered and used, namely, nightclub services. As a result, the registrations for Defendant IBZ's marks should never have been granted.

142. As set forth above and in detail in CLUBSPACE's cancellation petitions filed with the TTAB on October 2, 2013, incorporated herein by reference, Defendant IBZ's U.S. Federal Trademark Registrations for SPACE IBIZA, SPACE DANCE CHICAGO, SPACE DANCE NEW YORK, SPACE DANCE MIAMI, and SPACE DANCE LAS VEGAS are vulnerable to cancellation because they have never been used in commerce in the United States and are not currently in use in commerce in the United States. As a result, the registrations for Defendant IBZ's marks should be cancelled in their entirety.

143. As a result of the foregoing false and/or fraudulent conduct in connection with the registration of U.S. trademarks, CLUBSPACE was, is, and will continue to suffer damages and immediate, irreparable harm, both to it and its valuable CLUBSPACE Mark. CLUBSPACE has no adequate remedy at law.

144. In light of the foregoing, this Court should issue an order pursuant to 15 U.S.C. § 1119 (i) determining that Defendant IBZ's marks are vulnerable to cancellation for fraud, likelihood of confusion/CLUBSPACE's prior use, and/or Defendant IBZ's non-use; (ii) ordering the cancellation of these registrations in their entirety, (iii) certifying the order cancelling these registrations to the Director of the USPTO, who shall make appropriate entry upon the records of the USPTO, and (iv) granting Plaintiff CLUBSPACE such other and further relief as this Court deems just and proper, including but not limited to recovery of all damages CLUBSPACE has sustained, is sustaining, or will sustain, and all gains, profits, advantages, etc., obtained by Defendants as a result of their false or fraudulent registration of trademarks, in an amount not yet known but to be determined at trial, and the costs of this action.

COUNT IV

Unfair Competition

New York State Common Law

145. Plaintiff CLUBSPACE repeats and re-alleges the allegations contained in paragraphs 1 through 144, above, as though fully set forth herein.

146. Defendants' conduct, described above, constitutes unfair competition under New York common law. Without limitation, Defendants have adopted a business name in connection with restaurant, nightclub, bar, and/or cabaret services that is likely to be inherently confusing and to cause mistake among the consuming public and trade as to the source, approval, origin, or sponsorship of Defendants' services.

147. CLUBSPACE has been, is, and will continue to be irreparably harmed as a result of Defendants' conduct—that is, unless and until Defendants are enjoined by this Court.

148. As set forth above, CLUBSPACE has no adequate remedy at law.

149. In light of the foregoing, CLUBSPACE is entitled to an injunction prohibiting Defendants from using the term "SPACE NY," or any confusingly similar term, in connection with any nightclub services, and to recover from Defendants all damages CLUBSPACE has sustained, is sustaining, or will sustain, and all gains, profits, advantages, etc., obtained by Defendants as a result of their infringing acts, in an amount not yet known but to be determined at trial, and as well as costs, expenses, and attorneys' fees and such other and further relief this Court deems just and proper.

PRAYER FOR RELIEF

WHEREFORE, Plaintiff CLUBSPACE demands judgment against Defendants and each of them as follows:

1. For an order preliminarily and permanently enjoining and restraining Defendants, their affiliates, subsidiaries, parents, and their respective officers, agents, servants, attorneys, employees, and assigns, and all persons in active concert or participation with them, and mandating that Defendants forever cease and desist and refrain in the future from:
 - a. Using the business name “SPACE NY” in connection with any marketing, advertisement, or promotion, or offer for sale or sale of any nightclub services in the United States
 - b. Imitating, copying or making unauthorized use of Plaintiff’s CLUBSPACE Mark, including as a business name;
 - c. Selling, offering for sale, advertising, promoting, or displaying any service bearing any unauthorized reproduction, copy, or colorable imitation of the CLUBSPACE Mark;
 - d. Using any unauthorized colorable imitation of the CLUBSPACE Mark, including, but not limited to the CLUBSPACE Mark or the term “SPACE NY,” or any confusingly similar term(s), in connection with nightclub services in the United States;
 - e. Engaging in any other activity constituting unfair competition with Plaintiff or constituting an infringement of the CLUBSPACE Mark or Plaintiff’s rights in, or its right to use or exploit such trademark and the reputation and goodwill associated with the trademark; or

f. Engaging in any other activity, including the effectuation of assignments or transfers of its interests in unauthorized colorable imitations of the CLUBSPACE trademark, or the formation of other corporations, partnerships, associations, or other entities, or the utilization of other devices, for the purposes of circumventing, evading, avoiding or otherwise violating the prohibitions set forth in the preceding subsections of this paragraph.

2. For judgment that:

- g. Defendants have violated section 32(I) of the Lanham Act;
- h. Defendants have violated section 43(a) of the Lanham Act;
- i. Defendant IBZ false or fraudulently registered trademarks in violation of section 38 of the Lanham Act;
- j. Defendants have engaged in unfair competition in violation of New York State common law;
- k. Defendants at all times acted in bad faith, willfully, intentionally, and/or with reckless indifference to Plaintiff's prior, exclusive trademark rights;

2. For an order:

- a. Cancelling the following U.S. Federal Trademark Registrations in their entirety based on fraud, likelihood of confusion/CLUBSPACE's prior registration, and/or Defendant IBZ's non-use:
 - i. SPACE DANCE (Reg. No. 3,233,552) (fraud);
 - ii. SPACE IBIZA (Reg. No. 4,065,934) (likelihood of confusion/CLUBSPACE's prior registration; Defendant IBZ's non-use);

- iii. SPACE DANCE CHICAGO (Reg. No. 4,257,881) (fraud; likelihood of confusion/CLUBSPACE's prior registration; Defendant IBZ's non-use);
 - iv. SPACE DANCE NEW YORK (Reg. No. 4,214,158) (fraud; likelihood of confusion/CLUBSPACE's prior registration; Defendant IBZ's non-use);
 - v. SPACE DANCE MIAMI (Reg. No. 4,257,882) (fraud; likelihood of confusion/CLUBSPACE's prior registration; Defendant IBZ's non-use);
and
 - vi. SPACE DANCE LAS VEGAS (Reg. No. 4,257,875) (fraud; likelihood of confusion/CLUBSPACE's prior registration; Defendant IBZ's non-use);
and
- b. Directing the Director of the USPTO to make appropriate entry upon the records of the USPTO that the above registrations are cancelled in their entirety;
- 3. For an order requiring Defendants to account for and pay over to CLUBSPACE all profits realized by their wrongful acts and directing that such profits be trebled, since Defendants' actions were willful;
 - 4. For an order awarding CLUBSPACE its costs and reasonable attorneys' and investigative fees and expenses, together with prejudgment interest; and
 - 5. For an order awarding CLUBSPACE such other and further relief as this Court deems just and proper.

JURY TRIAL DEMAND

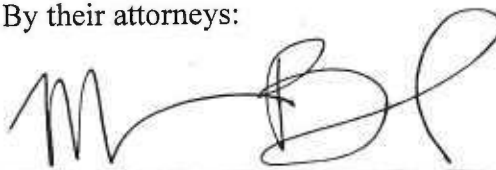
Plaintiff CLUBSPACE respectfully demands a trial by jury on all claims and issues so triable.

Dated: New York, New York
November 8, 2013

Respectfully submitted,

CLUB SPACE MANAGEMENT, LLC,
d.b.a. CLUB SPACE

By their attorneys:

A handwritten signature in black ink, appearing to be 'M Ballard', written over a horizontal line.

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**IN UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Reg. No. : 4257881
Mark : SPACE DANCE CHICAGO & Device
Respondent : Space IBZ Planet, S.L.

Club Space Management, LLC)	
d/b/a Club Space)	
)	
Petitioner,)	Cancellation No. 92057967
)	
v.)	
)	
Space IBZ Planet, S.L.,)	
Respondent.)	

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing **RESPONDENT'S MOTION TO SUSPEND CANCELLATION ACTION PENDING FINAL DISPOSITION OF PENDING CIVIL LITIGATION** was served this November 12, 2013, by First Class Mail, postage prepaid, on Petitioner's Counsel of Record at the following address:

Marcella Ballard
Victoria Danta
Venable LLP
1270 Avenue of Americas, 24th Floor
New York, New York 10020

By: /Sean S. Swidler/
Sean S. Swidler
Attorney for Opposer
Space IBZ Planet, S.L.